

REMARKS

Claims 1-6 and 8-20 are all the claims pending in the application. By this Amendment, Applicant adds claims 18-20, which are clearly supported throughout the specification.

I. Summary of the Office Action

Claim 17 is rejected under 35 U.S.C. § 112, first paragraph. Claims 1-6 and 8-17 are rejected under 35 U.S.C. § 103.

The Examiner alleges that claim 17 is rejected under 35 U.S.C. § 103(a). However, the features of the claim 17 are not addressed in the body of the Office Action mailed January 23, 2007. Applicant respectfully brings to the Examiner's attention that claim 17 is not addressed in the prior art rejection. Accordingly, the Examiner is respectfully requested to indicate that claim 17 contains allowable subject matter or if a rejection for claim 17 is necessary, the Examiner is respectfully requested to issue a new Non-Final Office Action that would address the features of claim 17 with respect to the prior art of record. MPEP §§ 707.07(i) and 710.06.

II. Claims Rejected Under 35 U.S.C. § 112

Claim 17 is rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner contends that "without access into a database that stores locations of WLAN access points" is not described in the specification such as to enable one of ordinary skill in the art (*see* page 2 of the Office Action). Applicant respectfully disagrees. Applicant respectfully submits that clearly the specification at least implicitly supports the unique features of claim 17.

For example, it is disclosed that the problem with conventional techniques are that "this notification is not carried out in real time and uses stored information, without verifying the real

existence of the WLAN nor the availability of said latter for the concerned user” (*see* page 2, lines 6 to 8). That is, the specification discloses that in conventional techniques stored information is used *i.e.*, a database, to determine the presence of WLAN. This conventional technique is disadvantageous at least because there is no verification of the actual or real existence of WLAN.

Accordingly, in an exemplary, non-limiting embodiment of the present invention, the mobile data terminal 3 periodically scans for the existence of WLAN based on detection of the subscriber network identifier. That is, the user knows, without effort, that an available WLAN can be accessed from his or hers present location and can connect right away without any further checking (*see* page 4, lines 9 to 19 of the specification). If the presence of the WLAN was detected based on a database that stores location of WLAN access points, then further checking would be necessary *e.g.*, to verify that the WLAN access point is not broken or down for maintenance. In other words, an exemplary, non-limiting embodiment at least implicitly supports detecting WLAN access point without accessing any databases that would store locations of WLAN access points.

Therefore, Applicant respectfully submits that claim 17 is supported by the specification. Applicant respectfully requests the Examiner to withdraw this rejection of claim 17.

III. Claims Rejected Under 35 U.S.C. § 103

Claims 1-6 and 8-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gunnarsson in view of U.S. Patent No. 6,959,207 to Keinonen (hereinafter “Keinonen”). Applicant respectfully traverses these grounds for a rejection in view of the following comments.

The present invention is directed to a technique for notifying a mobile telephone user of the availability of WLAN services. As described in the background section of the application, a known technique would be to keep track of the location of the mobile telephone, compare this against a database of known WLAN locations, and send a message to the mobile phone user when there is a known WLAN in that location. At least one problem with this is that it is based on stored information, and it may be, e.g., that the WLAN is not actually operational or is otherwise unavailable. According to the invention, the user's mobile data terminal (*i.e.*, the portable computer or other device that will connect to the WLAN) detects radio signals broadcast by the WLAN, and the mobile data terminal then sends a message to the mobile telephone notifying the user that a WLAN is available. Independent claims 1, 6, and 8 all include some variation of a mobile data terminal detecting signals broadcast by the WLAN and informing of access to the WLAN by sending a signal from the mobile data terminal to the radiotelephone terminal.

The Examiner contends that Gunnarsson discloses the mobile data terminal detecting signals broadcast by the WLAN. The Examiner acknowledges that Gunnarsson does not disclose or suggest informing of access to the WLAN by sending a signal from the mobile data terminal to the radiotelephone terminal. The Examiner, however, contends that Keinonen cures the above-identified deficiencies of Gunnarsson (*see* page 3 of the Office Action). Applicant respectfully disagrees.

Gunnarsson is not different from the prior art technique disclosed in Applicant's specification. That is, in Gunnarsson, a mobile terminal 60 (a cellular phone), which

communicates with a wireless communication network such as a TIA/EIA/IS-2000 network, and the user location is determined via the mobile terminal 60 (§§ 20 and 22). **In Gunnarsson, the user location is then compared to the known location and extent of WLANs 20**, e.g., from a database or other information resource within the communication network 10 (§ 22). The wireless communication network then sends a message to the mobile telephone, as a result of which the WLAN interface in the personal computer can be activated to search for and connect to the WLAN (§ 24).

Accordingly, it is clear that Gunnarsson does not detect the availability of the WLAN by having the mobile data terminal detect **signals broadcast from the WLAN**, but instead by having the mobile telephone network compare the mobile telephone location to **known WLAN locations**. In other words, the mobile terminal 60 simply compares its location to positional data of the WLANs in a database. The wireless computing device 70 receives its information about the presence of WLAN from the mobile terminal 60 via a paging message (§ 22). That is, in Gunnarsson, both, the mobile terminal 60 and the wireless computing device 70, do not detect the presence of the WLAN by receiving signals broadcasted by the WLAN.

In addition, as acknowledged by the Examiner, Gunnarsson does not disclose or suggest the mobile data terminal informing of access to the WLAN by sending a signal to the radiotelephone terminal. Keinonen does not cure the above-identified deficiencies of Gunnarsson. In particular, Keinonen is a non analogous reference that fails to disclose or even remotely suggest a mobile data terminal detecting signals broadcast by the WLAN and informing of access to the WLAN by sending a signal from the mobile data terminal to the radiotelephone

terminal. Furthermore, one of ordinary skill in the art would not have and could not have combined the references in the manner suggested by the Examiner.

In particular, Keinonen discloses an emotional notification system, where information about another party is entered into and stored in a terminal of a first party along with one or more data objects associated with the second party (such as an email from, to or about the second party, a file originated by the second party, etc.). Each time the first party activates at his terminal through an interface module a data object associated with a second party, a notifying message is sent to the second party to make the second party aware that the first party is devoting attention to the second party and to promote bonding between the two parties. The notifying message may take one of various, preferably unobtrusive forms, such as a vibration of a terminal belonging to the second party, which minimizes any distraction caused by the notifying message (*see* Abstract).

Clearly, Keinonen is a non analogous art. In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. MPEP 2141.01(a). In Keinonen, the field of endeavor is notifying a person that other persons are devoting their attention to that person (col. 1, lines 5 to 12). Keinonen addresses the problem that existing email programs are not designed to support the emotional cohesion of mutually significant persons (col. 2, lines 18 to 24). In other words, Keinonen is clearly not related to detecting WLANs and informing of their existence. Keinonen

relates to an emotional notification application for communicating emotions between various users. Therefore, Keinonen is non analogous art.

Furthermore, the Examiner contends that col. 7, lines 55 to 57, col. 8, lines 5 to 15, and col. 8, line 65 to col. 9, line 3 of Keinonen allegedly disclose informing the person that he or she can access said WLAN (see page 3 of the Office Action). Col. 7, lines 55 to 57, col. 8, lines 5 to 15, and col. 8, line 62 to col. 9, line 3 of Keinonen recite:

The notification interface informing the communication partner at terminal 110 that the subject's data objects of the communication partner have been activated in another remote terminal should be intimate and attention catching, and preferably unobtrusive to others.

The notification device 135 may be designed to be worn by the receiver of the message. Auditory or visual notifying messages, such as background sounds or changes in illumination, are also possible alternatives to a tactile notification in a situation when an ambient background interface can be constructed, i.e., in a quiet room or study. These auditory or visual notifying messages can similarly be conveyed on terminal 110, such as displaying a visual message on display 202 or playing the message over speaker 221, or they can be further transmitted for conveyance to the communication partner on notification device 135.

The user activates the data objects on the server 150 at terminal 100 using the network access software to access the software 152 at server 150 or software 222 at terminal 100 to track the activation of data objects and generate the notifying messages.

Notifying messages generated at server 150 are sent over the network/Internet 140 to the mobile network 120 for transmission to terminal 110. Notifying messages generated at terminal 100 are transmitted to terminal 110 via mobile network 120.

In other words, Keinonen only discloses having a notifying message that contains a data object.

In Keinonen, the data object is an electronically-represented data object, such as received email message, phonebook entry and an avatar that the user associates with a particular person to whom he or she feel an affinity (Fig. 6; col. 1, lines 27 to 34). In other words, Keinonen does not disclose or even remotely suggest that the notification informs of access to the WLAN. In short, Keinonen does not cure the above-identified deficiencies of Gunnarsson.

Furthermore, one of ordinary skill in the art would not have and could not have combined the references in the manner suggested by the Examiner. The Examiner contends that one of ordinary skill in the art would have been motivated to incorporate the sending of notifications so that notifications can be send (*see* pages 3-4 of the Office Action). In short, the Examiner appears to allege that one of ordinary skill in the art would have combined a component so as to have this particular component. This circular reasoning does not provide the necessary motivation.

The Board recognizes that the USPTO is held to a rigorous standard when trying to show that an invention would have been obvious in view of the combination of two or more references. See, *In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), citing, e.g., *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is

rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”). In *Lee*, the Federal Circuit further emphasized that the “need for specificity pervades this authority.” (*Lee* at 1433 (citing *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”))). The factual inquiry into whether to combine references “must be based on objective evidence of record.” *Lee* at 1433. In other words, in the present case, the Examiner has not set forth any suggestion why one of ordinary skill in the art would have incorporated emotional messages of Keinonen into the system of Gunnarsson. It is Applicant’s position that one of ordinary skill in the art would never have combined these two very different references.

For at least these exemplary reasons, claims 1, 6, and 8 are patentable over the combined disclosure of Gunnarsson and Keinonen. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claims 1, 6, and 8 and their dependent claims 2-5 and 9-17.

With respect to claim 17, it is respectfully noted that the combined disclosures of Gunnarsson and Keinonen do not disclose or even remotely suggest the active WLAN access point being detected based on the presence signals alone without access into a database that stores locations of WLAN access points. For at least these additional reasons, claim 17 is patentable over Gunnarsson and Keinonen.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 10/664,867
Attorney Docket No.: Q77431

IV. New Claims

In order to provide more varied protection, Applicant adds claims 18-20, which are patentable by virtue of their dependency on claim 1 and for additional features set forth therein.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

/Nataliya Dvorson/
Nataliya Dvorson
Registration No. 56,616

Date: April 23, 2007